

REMARKS

Claims 7-13, 20-26, 33-39 and 53-96 are currently pending in the subject application and are presently under consideration. Claims 53, 62, 71, 80, and 96 have been amended as shown on pages 2-12 of the Reply. In addition, claims 7-13, 20-26, and 33-37 have been cancelled, and the subject matter of those claims has been re-added as new claims 97-127. This has been done to improve the readability of the claim set as a whole, and does not change the subject matter disclosed in the individual claims.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 7, 20, 33, 53-55, 58, 60-64, 67, 69-73, 76, 78-82 and 96 Under 35 U.S.C. §103(a)

Claims 7, 20, 33, 53-55, 58, 60-64, 67, 69-73, 76, 78-82 and 96 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hung (2002/0087584) and Lewis, *et al.* (U.S. 6,795,806 B1). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Hung nor Lewis, *et al.* teach or suggest each and every feature set forth in the subject claims.

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007) citing *Graham v. John Deere Co. of Kansas City*, 383 U. S. 1, 36 (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight” (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964))).

The subject claims relate to the transfer of document into folders. Upon receiving a document, such as an e-mail, a user can highlight a portion of the text that correlates to a destination folder name. The user can then click on the highlighted portion to send the document to the folder that corresponds to the highlighted text. If there is no existing folder corresponding to the selected text, a new folder can be created automatically prior to transferring the document. This transfer procedure can be performed multiple times on one document, so that the user can

send the document to multiple folders by repeatedly selecting different portions of the document. In particular, amended independent claim 53 recites, *receiving from a user of the apparatus an un-prompted identification of a portion of the document while presenting the document, wherein the un-prompted identification is performed without requiring the use of a special identification tool by **highlighting the portion of the document**; and automatically transferring the document into a folder associated with the identified portion when the user clicks on the highlighted portion.*

Hung fails to disclose such a method of triggering a document transfer. Hung relates to a message management system that allows a user to define an expression associated with a received message, wherein the expression is derived from the message contents and identifies a destination folder. Subsequent messages that satisfy the expression will be stored in the same folder. However, although the cited reference discloses that portions of the message text can be selection in order to build the associated expression, Hung does not teach that a message transfer can be triggered by highlighting a portion of the document and then clicking on the highlighted portion. Rather, as Figure 4 and the associated text in Hung illustrate, the process by which a user builds an expression and subsequently moves a message into a folder requires the user to navigate a number of prompts to facilitate building an expression. This is in sharp contrast to the method disclosed in the subject claims, which teaches that a user need only highlight a portion of a document and then click on the highlighted portion to trigger a transfer. Lewis, *et al.*, which relates to enhanced voice recognition techniques that incorporate an eye-tracking system in conjunction with the voice dictation system, likewise fails to disclose the aforementioned transfer method.

Similarly, amended independent claim 62 recites, *the unprompted identification is performed without requiring the use of a special identification tool by **highlighting the portion of the document**; and a third set of instructions for **automatically transferring the document into a folder associated with the identified portion when the user clicks on the highlighted portion**.* As noted *supra*, neither cited reference discloses that clicking on a highlighted portion of a document can trigger a file transfer.

Moreover, amended independent claim 71 recites, *the un-prompted identification is performed by **highlighting the portion of the document**; and means for automatically transferring the document into a folder associated with the identified portion when the user*

clicks on the highlighted portion. Likewise, amended independent claim 80 recites, *the un-prompted identification is performed without requiring the use of a special identification tool by **highlighting the portion of the document**; and wherein the processor is operable to automatically transfer the document into a folder in the memory when the user clicks on the highlighted portion, the folder associated with the identified portion based on the received, un-prompted identification.* As discussed above, neither Hung nor Lewis, *et al.* teach or suggest transferring a document to a folder by highlighting a section of the document and subsequently clicking on the highlighted portion.

Also, amended independent claim 96 recites, *the un-prompted identification is performed without requiring the use of a special identification tool by **highlighting the portion of the document**; and automatically transferring the document into a folder associated with the identified portion when the user clicks on the highlighted portion.* As discussed previously, neither cited reference teaches or suggests this method of triggering a transfer of a document to a folder.

In view of at least the foregoing, it is respectfully submitted that Hung and Lewis, *et al.*, individually or in combination, do not teach or suggest each and every feature set forth in amended independent claims 53, 62, 71, 80, and 96 (and all claims depending there from) and as such fail to make obvious the subject invention. It is therefore requested that this rejection be withdrawn.

II. Rejection of Claims 56, 57, 59, 65, 66, 68, 74, 75, 77, 83-89 Under 35 U.S.C. §103(a)

Claims 56, 57, 59, 65, 66, 68, 74, 75, 77, and 83-89 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hung (2002/0087584), Lewis, *et al.* (6,795,806) and Clark, *et al.* (6,725,228). However, claims 56, 57, and 59 depend from amended independent claim 53, claims 65, 66, and 68 depend from amended independent claim 62, claims 74, 75, and 77 depends from amended independent claim 71, and claims 83-89 depend from amended independent claim 80. As discussed in the previous section of the Reply with respect to these independent claims, neither Hung nor Lewis, *et al.* teach that a document is transferred to a folder by highlighting a portion of the document and subsequently clicking on the highlighted portion of the document. Clark, *et al.* fails to remedy this deficiency in those art references. Clark, *et al.* relates to a message management system whereby one or more shortcuts can be

created for a message, each shortcut associating the message to a particular folder. In this way, a single message can be associated with multiple folders. However, the method taught by Clark, *et al.* does not disclose that a message transfer can be triggered by highlighting a portion of the message and then clicking on the highlighted portion.

In view of at least the foregoing, it is respectfully submitted that Hung and Lewis, *et al.*, alone or in combination with Clark, *et al.*, do not teach or suggest all features set forth in amended independent claims 53, 62, 71, and 80. Consequently, this rejection should be withdrawn with respect to claims 56, 57, 59, 65, 66, 68, 74, 75, 77, and 83-89, which depend from those independent claims.

III. Rejection of Claims 10-13, 23-26, 36-39 and 90-95 Under 35 U.S.C. §103(a)

Claims 10-13, 23-26, 36-39 and 90-95 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hung (2002/0087584), Lewis, *et al.* (6,795,806) and Clark, *et al.* (6,725,228) and Internet Explorer 5, as taught by Freeze (“Sam’s Teach Yourself Microsoft Internet Explorer 5 in 24 hours”). However, claims 10-13, 23-26, and 36-39 depend from amended independent claim 53, and claims 90-95 depend from amended independent claim 80. As discussed *supra*, Hung, Lewis, *et al.*, and Clark, *et al.* do not teach or suggest triggering a transfer of a document to a folder by highlighting a portion of the document and subsequently clicking on the highlighted portion. Freeze, which teaches the fundamentals of Microsoft Internet Explorer 5, also fails to disclose such a transfer method. It is therefore respectfully requested that this rejection be withdrawn with respect to claims 10-13, 23-26, 36-39 and 90-95, which depend from independent claims 53 and 80.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [QUALP757US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731